

## **REMARKS**

The Examiner is thanked for the courteous telephone interview granted Applicants' representative on February 20, 2004. This Amendment has been drafted pursuant to comments and suggestions made by the Examiner during the interview; and, it is believed, places the application in condition for allowance.

The specification has been amended to correct a typographical error noted therein. No new matter has been added by the amendment.

Claims 1-30 remain pending in the present application. Claims 1-4, 7, 11, 12, 15-18, 21, 25, 26, 29 and 30 have been amended to more clearly distinguish over the cited art, and to correct minor typographical errors noted therein. No claims have been added. Applicants believe the claims currently in the case patentably distinguish over the cited art, and that this application is in condition for allowance in its present form. Reconsideration of the rejection is, accordingly, respectfully requested in view of the above amendments and the following comments.

### **I. Double Patenting**

The Examiner has provisionally rejected claims 1-30 under the judicially created doctrine of double patenting as being unpatentable over claims 11-12, 34-35 and 48 of copending U. S. Patent Application Serial No. 09/671,060. The Examiner states that although the conflicting claims are not identical, they are not patentably distinct because the step of creating a (test or response) message, which is not explicitly cited in claims 11-12, 34-35 and 48 of the copending application, is well-known in the prior art.

In order to expedite prosecution of the present application, claims 11-12, 34-35 and 48 in copending U. S. Patent Application Serial No. 09/671,060 have been canceled in an Amendment filed in that application concurrently herewith. As a result of the Amendment filed in the copending application, it is believed that any issues of double patenting have been overcome.

Therefore, the provisional rejection of claims 1-30 under the judicially created doctrine of double patenting has been overcome; and withdrawal of the provisional rejection is respectfully requested.

## **II. 35 U.S.C. § 102, Anticipation**

The Examiner has rejected claims 1-30 under 35 U.S.C. § 102(e) as being anticipated by Rollins (U. S. Patent No. 6,434,601). This rejection is respectfully traversed.

The present invention is directed to a procedure by which an electronic message sent to a recipient at an address on a server includes at least one delivery attribute identifier for identifying at least one delivery attribute. A response is received that includes validity information indicating whether the address is a valid address, and, in addition, at least one delivery attribute value corresponding to the at least one delivery attribute, the delivery attribute value including delivery information regarding the electronic message.

Advantages provided by the present invention include those described as follows on page 25, lines 18-24 of the specification:

The sender and recipient mail servers may include attributes in the test header to enhance the analysis of delivery failures. Using these attributes, the dead e-mail address locator can pinpoint the location of e-mail message delivery failure and profile the performance of routing of messages and other details hidden from users.

Rollins is directed to a technique for testing the address to which an e-mail message is to be sent during typing of the message and before an attempt is actually made to send the message. In Rollins, during the typing of an e-mail message, the existence of both the server and the addressee that are specified in the "To" field of the message are checked before the message is sent. If the server or the addressee does not exist, the patent suggests that the addressee's Internet e-mail address has been incorrectly typed, and the user is so informed.

In rejecting the claims, the Examiner states as follows:

Rollins discloses a pretest email system comprising:

- a) means for creating a pretest message including a ping and/or a test message, the pretest message having at least one delivery attribute including server address and/or recipient address (see col. 5, lines 31-44 and col. 6, lines 1-10),
- b) means for sending the message to the recipient,
- c) means for receiving a response including validity information indicating whether the address is valid (see col. 5, lines 45-60 and col. 6, lines 11-27),
- d) means for processing the delivery attribute value to form a failure analysis information and presenting the failure analysis information to the user (see col. 6, lines 28-39).

Office Action dated January 14, 2004, pages 3-4.

Claim 1 of the present application, as amended herein, reads as follows:

1. A method comprising:  
creating an electronic message having a recipient at an address on a server, wherein the electronic message includes at least one delivery attribute identifier for identifying at least one delivery attribute;  
sending the electronic message to the recipient; and  
receiving a response, the response including validity information indicating whether the address is a valid address, and at least one delivery attribute value corresponding to the at least one delivery attribute, the at least one delivery attribute value including delivery information regarding the electronic message.

Rollins does not disclose creating an electronic message having a recipient at an address on a server that includes at least one delivery attribute identifier for identifying at least one delivery attribute, nor does the reference disclose receiving a response that includes validity information indicating whether the address is a valid address, and at least one delivery attribute value corresponding to the at least one delivery attribute that includes delivery information regarding the electronic image (emphasis added).

In Rollins, when a cursor is moved from the "To" field to the "Subject" field during typing of an e-mail message, the e-mail program sends out a ping to the server specified in the "To" field to verify the existence of the server. As stated in column 4, lines 2-17 of Rollins:

...If the specified mail server does respond to the ping, it is an affirmative response which signals to the user's e-mail program the existence of the recipient's mail server (e.g. "host"), at step S22. In the case of such an affirmative response, the user is not notified (i.e., the pre test operates completely in the background).

If the specified mail server does not respond to the ping (i.e., if the ping "times out" without a response), it likely means that there is an error with the mail server portion of the specified e-mail address (i.e., an error in the way in which it was typed into the "To" field of the user's e-mail program). If such is the case, the program will return an error message at step S24. The error message will inform the user of the unknown host, giving the user an opportunity to correct the fatal error before the message is futilely sent.

When the user moves the cursor from the "Subject" field to the "Message" field, a test message is generated and sent to the same mail server to verify the existence of the addressee specified in the "To" field as a user on the mail server. As stated in column 4, lines 44-59 of Rollins:

Next, depending upon the response it receives from the addressee's mail server, the present invention determines whether the addressee does exist as a user on the addressee's mail server at step S30. The addressee's mail server, having standard configuration, will respond to the small test message in either the affirmative or the negative. If the response is in the negative, the user's e-mail program generates an error message, at step S32, prompting the user to check the accuracy of the username (e.g., spelling, etc.) which is currently in the "To" field with a valid host name.

If the response from the addressee's mail server is in the affirmative (i.e., the user name exists on the addressee's mail server), the addressee's mail server responds to the small test message with a message header, thereby confirming receipt of the small test message to the user's e-mail program at step S34.

Thus, in Rollins, during testing of the existence of both the mail server and the addressee specified in the addressee's Internet e-mail address, the specified mail server simply responds to the test message in either the affirmative or the negative (or does not respond at all in the case that the mail server has been incorrectly identified). In Rollins, accordingly, the response includes only information indicating whether an address is a

valid address. The response does not contain at least one delivery attribute value that includes delivery information regarding the electronic message as now recited in claim 1.

In particular, in the present invention, as now clearly recited in claim 1, an electronic message is created that has a recipient at an address on a server, and that also includes at least one delivery attribute identifier for identifying at least one delivery attribute. The electronic message is then sent to the recipient, and a response is received that includes validity information indicating whether the address is a valid address; and, “at least one delivery attribute value corresponding to the at least one delivery attribute, the at least one delivery attribute value including delivery information regarding the electronic message”.

During the above-mentioned telephone interview, the Examiner indicated that he believed the terms “delivery attribute” and “delivery attribute value” to be sufficiently broad in scope so as to be readable on Rollins. The Examiner suggested that the claims be amended to clarify the meaning of these terms so as to distinguish over Rollins.

It is believed that claim 1 as amended herein defines the terms “delivery attribute” and “delivery attribute value” in a manner that more clearly distinguishes the present invention over Rollins. Claim 1 as amended herein is, accordingly, believed to patentably distinguish over Rollins and to be allowable in its present form.

Claims 2-10 depend from and further restrict claim 1, and should also be allowable in their present form, at least by virtue of their dependency. Many of these claims, in addition, set forth features that are not taught by Rollins. For example, claim 2 depends from claim 1 and recites that the at least one delivery attribute identifier comprises at least one of a recipient mail system identifier, a recipient mail server identifier, a recipient router identifier, a sender mail system identifier, a sender mail server identifier and a sender router identifier. Claim 4 depends from claim 3 and specifies that the at least one delivery attribute value comprises an address including at least one of a recipient mail system address, a recipient mail server address, a recipient router address, a sender mail system address, a sender mail server address and a sender router address. Rollins does not disclose the subject matter of these claims, and claims 2 and 4 should be allowable in their own right as well as by virtue of their dependency.

Claim 3 depends from claim 1 and reads as follows:

3. The method of claim 1, wherein the validity information indicates that the address is an invalid address, the method further comprising:  
processing the at least one delivery attribute value to form delivery failure analysis information; and  
presenting the delivery failure analysis information.

As indicated above, the Examiner refers to column 6, lines 28-39 of Rollins as disclosing the subject matter of this claim. Column 6, lines 28-39 of Rollins reads as follows:

If, however, C<sub>1</sub>'s user has typed in an incorrect addressee (i.e., on the now verified existing server **208**), server **208** responds to the test message in the negative. That is, the server's **208** response to C<sub>1</sub> indicates that the addressee (as typed) does not exist as a user on server **208**. The negative response to the test message follows a path back to C<sub>1</sub> which is substantially the same as a path followed by the server's **208** response to the ping. Upon receiving the negative response from server **208**, C<sub>1</sub> then notifies the user of the e-mail program that there is an error with the address as types in the "To" field, prompting the user to correct the error before the actual message is sent in vain.

In Rollins, as indicated above, a response indicates only whether or not the addressee exists. There is no delivery attribute value in the response. Accordingly, Rollins does not process at least one delivery attribute value to form delivery analysis failure information, as recited in claim 3. Claim 3, accordingly, is also believed to be allowable in its own right as well as by virtue of its dependency.

Independent claims 11, 15, 25, 29 and 30 have been amended in a manner similar to claim 1, and those claims, together with the claims dependent thereon, should also be allowable in their present form for substantially the same reasons as discussed above with respect to claim 1.

Claims 1-30 would also not be obvious in view of Rollins. There is no disclosure in Rollins of including at least one delivery attribute identifier in an electronic message

for identifying at least one delivery attribute, nor does Rollins disclose including a delivery attribute value corresponding to the at least one delivery attribute in a response that includes delivery information regarding the electronic message. Only the present application contains such a disclosure, and in the absence of any such disclosure in Rollins, it would not be obvious to one of ordinary skill in the art to modify Rollins to achieve the present invention.

Therefore, the rejection of claims 1-30 under 35 U.S.C. § 102 has been overcome.

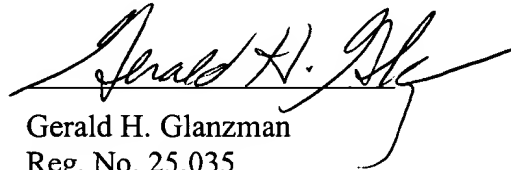
### **III. Conclusion**

For at least the above reasons, claims 1-30 are believed to patentably distinguish over Rollins and to be allowable in their present form. This application is, accordingly, believed to be in condition for allowance, and it is respectfully requested that the Examiner so find and issue a Notice of Allowance in due course.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: March 3, 2004

Respectfully submitted,



Gerald H. Glanzman  
Reg. No. 25,035  
Carstens, Yee & Cahoon, LLP  
P.O. Box 802334  
Dallas, TX 75380  
(972) 367-2001  
Attorney for Applicants